

Under 35 U.S.C. § 121 and 37 C.F.R. § 1.142, an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent or distinct. There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP §§ 802.01, 806.04, 808.01) or distinct as claimed (see MPEP §§ 806.05 - 806.05(i)), AND

(B) There must be a serious burden on the examiner (see MPEP §§ 803.02, 806.04(a)-806.04(i), 808.01(a), and 808.02).

To properly support a restriction requirement, the Examiner must provide reasons and/or examples to support conclusions (see, e.g., MPEP § 803). The Examiner has not provided any reasons why the different embodiments are independent (i.e., there is no disclosed relationship between the embodiments which are unconnected in design, operation, or effect) or distinct (e.g., each embodiment is capable of separate manufacture, use, or sale, AND are patentable over each other).

As such, the Examiner has failed to establish a prima facie case of independence or distinctness under element (A), above, and the restriction requirement is therefore improper.

With respect to element (B), above, and in accord with MPEP § 803, even if the application includes claims to independent or distinct inventions, "the examiner must examine [the application] on the merits" if the search and examination of the application can be made without serious burden. For purposes of this requirement, a serious burden on the examiner may be shown, for example, if the Examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search. In the present case, the Restriction Requirement is devoid of any showing of a serious burden on the Examiner.